

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 18-34 and 36-41 are currently pending. Claims 6-17 and 35 have been canceled without prejudice; Claims 18, 24, 25, and 30 have been amended; and Claims 36-41 have been added by the present amendment. The changes and additions to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 6-9 and 18-29 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,918,988 to H.A.M. Van Oijen (hereinafter “the ‘988 patent”); Claims 10-17 and 30-34 were rejected under 35 U.S.C. § 102(b) as being anticipated by European Patent Application Publication No. 0469865 to Dahlby et al. (hereinafter “the ‘865 patent”); and Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘988 and ‘865 patents.

Applicants respectfully submits that the rejection of Claims 6-17 and 35 are rendered moot by the present cancellation of those claims.

Amended Claim 18 is directed to a method of printing data files using an image printing device, comprising: (1) storing data files in a storage device associated with the image printing device; (2) selecting, in an arbitrary order, a plurality of the data files stored in the storage device; (3) displaying a serial number of each of the selected plurality of data files; (4) printing the selected plurality of data files, wherein the plurality of data files are printed in the selected order. Claim 18 has been amended to include the step of displaying the serial number of each of the selected plurality of data files. No new matter has been added.<sup>1</sup>

---

<sup>1</sup> See, e.g., Figures 7-9 and the discussion related thereto in the specification.

The '988 patent is directed to a printing system for carrying out print jobs in which print jobs are received and stored in memory, wherein the printing system has an interface so that print criteria can be set and altered by an operator. The '988 patent discloses that only the print jobs satisfying the print criteria set by the operator are printed. However, Applicants respectfully submit that the '988 patent fails to disclose the step of displaying a serial number of each of the selected plurality of data files, as recited in Claim 18. As shown in Figure 7A, the '988 patent discloses that the names of files in a job are displayed. However, Applicants respectfully submit that the '988 patent fails to disclose displaying the serial number of each of the selected plurality of data files, and then printing the selected plurality of files in the selected order, as recited in Claim 18. Accordingly, Applicants respectfully submit that the rejection of Claim 18 (and dependent Claims 19-23) are rendered moot by the present amendment to Claim 18.

Independent Claim 24 recites limitations analogous to the limitations recited in Claim 18. Moreover, Claim 24 has been amended in a manner analogous to the amendment to Claim 18. Accordingly, for reasons analogous to the reasons stated above for the patentability of Claim 18, Applicants respectfully submit that the rejections of Claim 24 (and dependent Claims 25-29) are rendered moot by the present amendment to Claim 24.

Independent Claim 30 is a computer program product claim reciting limitations analogous to the limitations recited in Claim 18.

Regarding the rejection of Claim 30, the '865 patent is directed to a method of automatically sorting jobs in a print queue according to the characteristics of a job to be printed and the selected printing priority. In particular, the '865 patent discloses steps of selecting an order in which jobs in the queue are to be printed, comparing a print medium program for each job of the print medium in the paper tray, and changing the order in which the jobs are arranged in the queue in accordance with the presence of the print medium in the

paper trays. However, Applicants respectfully submit that the '865 patent fails to disclose the step of displaying a serial number of each of the selected plurality of data files, as recited in amended Claim 30. Accordingly, Applicants respectfully submit the rejections of Claim 30 (and dependent Claims 31-34) are rendered moot by the present amendment to Claim 30.

The present amendment also sets forth new dependent Claims 36-41 for examination on the merits. New Claim 36, which depends from Claim 18, clarifies that the data files stored in the storage device include data from a host machine and data from a scanner. Further, new Claim 37, which depends from Claim 36, states that the method further comprises the step of displaying an indication of whether the data files stored in the storage device are from the host machine or from the scanner. New Claims 36 and 37 are supported by the originally filed specification and do not add new matter.<sup>2</sup> New Claims 38-41, which depend from Claims 24 and 30, recite limitations analogous to the limitations recited in Claims 36 and 37. Accordingly, Applicant respectfully submits that all of new Claims 36-41 are supported by the originally filed specification and do not add new matter. Further, Applicant respectfully submits that the limitations recited in new Claims 36-41 are not disclosed by the '988 or '865 patents, taken either singly or in proper combination.

Thus, it is respectfully submitted that independent Claims 18, 24, and 30 (and all associated dependent claims) patentably define over any proper combination of the '988 and '865 patents.

---

<sup>2</sup> See, e.g., Figs. 7-9 and the discussion related thereto in the specification.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

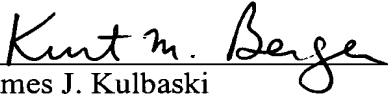
Customer Number

**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 03/06)

JJK/KMB/wr

I:\ATTY\KMB\243\S\243149US\243149US-AF.DOC

  
James J. Kulbaski  
Registration No. 34,648  
Attorney of Record

Kurt M. Berger, Ph.D.  
Registration No. 51,461